

TTAB



03-17-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #61

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

University of Southern California	)	Opposition No.: 125,615
	)	
Opposer,	)	Serial No.: 75/358,031
	)	
vs.	)	Mark: "SC" (Stylized)
	)	
University of South Carolina,	)	
	)	
Applicant.	)	
	)	

**APPLICANT'S ANSWER TO NOTICE OF OPPOSITION  
AND AMENDED COUNTERCLAIM FOR CANCELLATION**

The Applicant, University of South Carolina ("Applicant"), through its undersigned attorneys, hereby submits its Answer to the Notice of Opposition filed by University of Southern California ("Opposer") against its application for registration of the mark "SC" (Stylized), Serial No.: 75/358,031, filed September 16, 1997, and published in the Official Gazette of May 18, 1999, as follows:

1. Unless expressly admitted herein, each allegation contained in the Notice of Opposition is denied.
2. As to paragraph 1 of the Notice of Opposition, Applicant lacks information sufficient to form a belief as to whether the Notice of Opposition was timely filed, and therefore, denies those allegations. The Applicant admits the remaining allegations of paragraph 1 of the Notice of Opposition.
3. As to paragraph 2 of the Notice of Opposition, Applicant admits only that Opposer has received a registration for "SC," U.S. Reg. No. 1,844,953 and that this

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registration speaks for itself. Applicant lacks information sufficient to form a belief as to the truth of the remaining allegations of paragraph 2 of the Notice of Opposition, and therefore, denies those allegations.

4. Applicant denies the allegations of paragraph 3 of the Notice of Opposition and would further show that there is no likelihood of confusion between Opposer's and Applicant's marks.

5. Applicant denies the allegations of paragraph 4 of the Notice of Opposition and would further show that it is senior in priority having used the letters "SC" as a mark at least as early as 1898, if not earlier.

6. Applicant denies the allegations of paragraph 5 of the Notice of Opposition.

7. As to paragraph 6 of the Notice of Opposition, Applicant lacks information sufficient to form a belief as to the truth of the allegations regarding the extent of Opposer's advertisements and its expenditures, and therefore, denies those allegations. Applicant denies the remaining allegations of paragraph 6 of the Notice of Opposition.

8. Applicant denies the allegations of paragraph 7 and 8 of the Notice of Opposition.

9. Applicant denies the allegations of paragraph 9 of the Notice of Opposition and would further show that there is no possibility of any injury to Opposer through the granting of Applicant's registration.

### **FIRST AFFIRMATIVE DEFENSE**

10. Opposer's Notice of Opposition fails to set forth facts sufficient to entitle the Opposer to the relief sought and should be dismissed pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure. Applicant reserves the right to file a motion to dismiss.

### **SECOND AFFIRMATIVE DEFENSE**

11. Opposer is not entitled to relief because there is no likelihood of confusion, mistake or deception because the Opposer's mark and the Applicant's mark are not confusingly similar, are used in connection with dissimilar goods and services, are sold through different channels of trade, and the relevant consuming public are discerning customers who can easily differentiate between their favorite team's products.

### **THIRD AFFIRMATIVE DEFENSE**

12. Opposer is not entitled to relief under the doctrine of unclean hands based upon its fraud in obtaining U.S. Registration No. 1,844,953.

### **FOURTH AFFIRMATIVE DEFENSE**

13. Opposer is not entitled to relief because Opposer's marks are generic or descriptive and incapable of serving as an indicator of source.

### **FIFTH AFFIRMATIVE DEFENSE**

14. Opposer lacks standing to bring this Opposition Proceeding.

### **SIXTH AFFIRMATIVE DEFENSE**

15. Opposer's Notice of Opposition should be dismissed because Opposer has previously released any claims against Applicant.

**SEVENTH AFFIRMATIVE DEFENSE**

16. Opposer should be estopped from opposing Applicant's registration of the "SC" (Stylized) mark.

**EIGHTH AFFIRMATIVE DEFENSE**

17. Opposer has waived any and all claims against Applicant over the use of the "SC" (Stylized) mark.

**COUNTERCLAIM FOR CANCELLATION OF OPPOSER'S MARK**

**AS A FIRST COUNTERCLAIM**  
**(Fraudulent Registration)**

18. Applicant hereby incorporates its defenses and allegations contained in paragraphs 1 through 17.

19. On September 5, 1990, Opposer filed an Intent to Use trademark application for the letters "SC." This application was given Serial No. 74/094,681. In this application, Opposer made a statement under oath to the U.S. Patent and Trademark Office that it had a bona fide intention to use the mark contained in the application for Serial No. 74/094,681 in connection with the goods contained in International Classes 6, 18, 24 and 25 of the application.

20. On or about January 19, 1994, Opposer filed a statement of use for Serial No. 74/094,681. In this document, Opposer made a statement under oath to the U.S. Patent and Trademark Office that it had, in fact, first used the mark "in commerce *on all of the goods*" contained in International classes 6, 18 24 and 25, as follows: in International Class 6 since 1926 and in interstate commerce in International Class 6 since 1978; in International Class 8 since 1926 and in interstate commerce in International Class 8 since 1987;

in International Class 24 since 1926 and in interstate commerce in International Class 24 since 1987; and in International Class 25 since 1926 and in interstate commerce in International Class 8 since 1987. This statement contained information material to the application and the U.S. Patent and Trademark Office relied upon this statement in issuing U.S. Registration No. 1,844,953.

21. Upon information and belief, the Opposer's representations regarding the dates of first use of the mark in connection with the goods contained in the application were both false and misleading.

22. Opposer knew or should have known that the representations were false.

23. Opposer intended for the U.S. Patent and Trademark Office and the public to rely on its representations and such reliance on the Opposer's representations was reasonable under the circumstances.

24. Applicant has since been damaged as a result of Opposer's fraudulent procurement of U.S. Registration No. 1,844,953.

**AS A SECOND COUNTERCLAIM**  
**(Cancellation under Section 2(b), 15 U.S.C. § 1052(b))**

25. Applicant hereby incorporates its defenses and allegations contained in paragraphs 1 through 24.

26. The Carolinas were explored and settled in approximately 1521 by Francisco de Gordillo. The Spanish tried unsuccessfully to establish a colony near present-day Georgetown in 1526, and the French also failed to colonize Parris Island near Fort Royal in 1562. The first European attempts at settlement failed, but in 1670 a permanent English

settlement was established on the coast near present day Charleston. The colony, named Carolina after King Charles I, was divided in 1710 into South Carolina and North Carolina.

27. South Carolina was the eighth of the original 13 colonies and became a State on May 23, 1788.

28. Since at least as early as the Revolutionary War, in approximately 1775, the government that became the State of South Carolina adopted the abbreviation "SC" as a symbol and insignia of the State of South Carolina. For instance, the letters "SC" were used on uniforms, flags and other items during the Revolutionary War and Civil War by the State of South Carolina.

29. The letters "SC" have also been used as an official abbreviation of the words "South Carolina" since at least as early as the creation of the State of South Carolina by the Federal Government, the State of South Carolina and by the public throughout the world. The letters "SC" are the official State Abbreviation assigned to the State of South Carolina by the United States Postal Services and other agencies of the Federal Government.

30. The Opposer's registration of the letters "SC" in Registration No. 1,844,953 are identical to the letters "SC" previously used by the State of South Carolina.

31. The letters "SC" point uniquely and unmistakably to the State of South Carolina.

32. The Opposer's registration of the letters "SC" in U.S. Registration No. 1,844,953 consists of a flag or insignia of the State of South Carolina.

33. As a result, the Applicant has been damaged by Opposer's registration of U.S. Registration No. 1,844,953.

**AS A THIRD COUNTERCLAIM**  
**(Cancellation under Section 2(a), 15 U.S.C. § 1052(a))**

34. Applicant hereby incorporates its defenses and allegations contained in paragraphs 1 through 33.

35. The Opposer's registration of the letters "SC" in Registration No. 1,844,953 are identical to the letters "SC" previously used by the State of South Carolina.

36. The letters "SC" have been used for over 200 years by the State of South Carolina and point uniquely and unmistakably to the State of South Carolina.

37. The Opposer is not connected with, sponsored by or related in any way with any activities performed by the State of South Carolina.

38. The Opposer's registration of the letters "SC" in U.S. Registration No. 1,844,953 consists of letters that falsely suggest a connection with the an institution or national symbol; namely, the State of South Carolina.

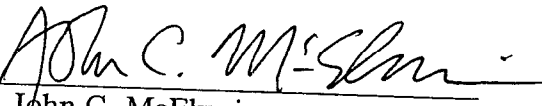
39. As a result, the Applicant has been damaged by Opposer's registration of U.S. Registration No. 1,844,953.

WHEREFORE, having fully answered the Notice of Opposition and having filed its Amended Counterclaim, the Applicant prays that the Opposition be dismissed, with prejudice, that its registration issue forthwith, that Opposer's registration for U.S. Registration No. 1,844,953 be cancelled, and for such other and further relief as the Trademark Trial and Appeal Board may deem just and proper.

The required \$300.00 fee for the Counterclaim has been previously submitted.

NELSON MULLINS RILEY & SCARBOROUGH, L.L.P.

By:

  
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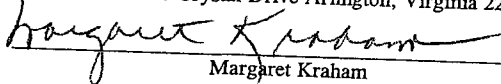
Charleston, South Carolina

Attorneys for the University of South Carolina

8/1, 2002

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, Virginia 22202-3513.

  
Margaret Kraham

Date: 08/01/2002



## CERTIFICATE OF SERVICE

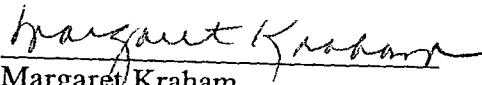
I, the undersigned Administrative Assistant of the law offices of Nelson Mullins Riley & Scarborough, L.L.P., attorneys for Applicant do hereby certify that I have served all counsel in this action with a copy of the pleading(s) hereinbelow specified by mailing a copy of the same by United States Postal Service First Class Mail, with proper postage thereon, to the following address(es):

Pleadings:

Answer to Notice of Opposition

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LAW OFFICES

03-17-2003

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March 13, 2003

**BOX TTAB**

**NO FEE**

Jyll S. Taylor, Esq.  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

RE: University of Southern California v. University of South Carolina  
Our File No.: 13524/01501

Dear Ms. Taylor:

Pursuant to the request contained in your mailing of February 10, 2003, enclosed please find a copy of the University of South Carolina's original answer and counterclaims in the above referenced matter. Please contact me if you have any questions.

03 MAR 27 AM 9:30  
TRADEMARK TRIAL AND  
APPEAL BOARD

Very truly yours,

Matthew D. Patterson

Enclosures

cc: Scott A. Edelman  
Michael S. Adler

JB